

REMARKS

The foregoing amendments are made in connection with Applicant's Request for Continued Examination filed concurrently herewith, and are accompanied by a Supplemental Information Disclosure Statement, a Declaration of Francesca Kuglen under 37 CFR 1.131, and the Declarations of Karen Giberson and Francesca Kuglen under 37 CFR 1.132. Also, Applicant has submitted to the Examiner via Federal Express specimens of the following: An embodiment of a stretch comb hair retainer described and claimed in the present application; a specimen of a wig called Holiday Magic having a mesh base of the type that is believed to be similar to the mesh base disclosed in the Ruffio patent (U.S. 1,665,380); and a specimen of the Look of Love hairpiece shown on page 18 of the Look of Love catalog submitted with Applicant's information disclosure statement dated October 3, 2007.

Status of Application

Prior to the foregoing amendments, claims 1-31 were pending in this application, of which claims 1-15, 17-25 and 29-31 were finally rejected and claim 16 was objected to as being dependent upon a rejected base claim. Claims 26-28 were allowed. (Final Office Action dated January 8, 2008.) Applicant filed a Notice of Appeal on July 7, 2008.

The foregoing amendments as to the previously presented claims and the following remarks are responsive to the Examiner's final action dated January 8, 2008. Claims 1, 15, 21, and 23 are currently amended to clarify the invention recited therein.

Claim 20 is currently amended to correct a noted grammatical error. Claim 29 has been amended so that it is substantially the same as the claim published in Applicant's published application. Claims 32-35 have been added.

In view of the foregoing amendments and following remarks and the accompanying submissions, reconsideration of the present application is respectfully requested.

Claim Rejections under 35 U.S.C. §102

1. Claims 1 and 6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 1,665,380 to Ruffio ("Ruffio").

Claim 1 recites a stretch comb hair retainer comprised of two opposed combs. Each comb has a spine defining the width of the comb and comb teeth projecting from the spine. A stretchable elastic mesh is secured between the spines of the two combs to produce tension between the combs. The elastic mesh has a width comparable to the width of the combs, and is formed by elastic strands extending between the spines of the combs so as to form stretchable openings which can individually be stretched open to allow an amount of the wearer's hair to be pulled through individual openings. To clarify the invention and to address the Examiner's concerns about the Ruffio patent, Applicant has amended claim 1 to recite that the elastic strands are capable of being threadedly beaded to provide a decorative elastic mesh. Ruffio discloses a mesh that is not formed by elastic strands capable of being beaded by threading, but rather a closely woven net

onto which beads could not be threaded.

Despite the Section 132 declarations of Applicant's experts (Ingrid Johnson and John Callanan) to the contrary, the Examiner has repeated her contention that Ruffio discloses stretchable openings which can be stretched open so that an amount of the wearer's hair can be pulled through the stretchable openings. Citing MPEP 716.01(b), the Examiner contends that Applicant's declarations are insufficient to overcome the rejections of claims 1 and 6, as well as claims 2-5, 17-25 and 29-31, because of a lack of a nexus between the subject matter recited in the rejected claims and the "evidence of the secondary considerations." Applicant would point out that the Johnson and Callanan declarations were not submitted as evidence of secondary considerations of non-obviousness, but to interpret the Ruffio patent, and what the Ruffio disclosure, when read as a whole, would mean to a person of ordinary skill in the art. The declarations of Ms. Johnson and Mr. Callanan support Applicant's contention that, although Ruffio discloses the woven fabric material to be "elastic," this does not mean that the woven fabric of Ruffio discloses a material having stretchable openings through which an amount of the wearer's hair can be pulled. Further, Ruffio does not disclose an elastic mesh formed by elastic strands extending between the spines of the combs that are capable of being beaded by threading the beads onto the mesh.

To assist the Examiner's understanding of the differences between Ruffio and the stretch comb hair retainer recited in claims 1 and 6, Applicant has separately provided to

the Examiner a prior art wig having a mesh base which is believed to be similar to the type of mesh base disclosed in the Ruffio patent (U.S. 1,665,380), and a specimen of the Look of Love hair piece shown on page 18 of the Look of Love catalog submitted with Applicant's information disclosure statement dated October 3, 2007. Applicant has also provided the Examiner a specimen of one embodiment of Applicant's stretch comb hair retainer, which has beaded elastic strands, and in which the openings formed by the strands can be readily stretched open to allow hair to be pulled through the openings. The specimens of the prior art wig and Look of Love hair piece demonstrate that the openings in the mesh base of these hair piece items can not be stretched open so that a wearer's hair can be pulled through the hair piece.

For at least these reasons, it is respectfully submitted that claims 1 and 6 are not anticipated by Ruffio. Applicant therefore respectfully requests that the Examiner's rejection of claims 1 and 6 under 35 U.S.C. 102(b) be withdrawn.

Claim Rejections under 35 U.S.C. §103

1. Claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ruffio.

Claims 3 and 4 depend from independent claim 1. Claim 3 recites that the elastic strands are secured at spaced intervals to the spines of the combs and claim 4 recites that the strands are interconnected and form an elastic mesh formed at least in part by generally triangular-shaped stretchable openings.

As previously discussed by Applicant, Ruffio does not disclose an elastic mesh having stretchable openings or give any indication that the disclosed woven fabric has the sort of elasticity that will provide stretchable openings that can individually be stretched open so that an amount of the wearer's hair can be pulled through the openings. See Callanan and Johnson Declarations. Rather, Ruffio points to the use of a woven fabric having relatively minimal elasticity, for example, by requiring an adjustable buckle to accommodate different sized heads. Ruffio effectively teaches away from the use of elastic strands to form an elastic mesh with stretchable openings that can individually be stretched open by teaching a mesh construction that would likely be damaged by any attempt to do so.

For at least these reasons, it is submitted that claims 3 and 4 are patentable over Ruffio.

2. Claims 2, 5, 12-14, 21-22 and 29-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ruffio in view of Japan Patent No. 409299131 ("JPN '131").

With regard to claims 2 and 29-31 these claims recite a stretch comb hair retainer comprised of two opposed wire combs, wherein each wire comb is comprised of a metal spine and looped wire teeth attached to and projecting from the metal spine. Claim 2 depends from independent claim 1 discussed above.

With regard to claims 5 and 12-14, it is noted that these claims do not recite wire combs as indicated by the Examiner.

With respect to claims 21 and 22, these claims are currently amended to recite that the two opposed combs have a spine with wire loop comb teeth projecting from the spine.

Combs having wire loops as comb teeth are referred to herein as “wire loop combs.” With respect to the wire loop combs, the Examiner states:

It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the particular comb as taught by JP ‘131 into the hair retainer of Ruffio in order to provide flexibility to the teeth of the combs so that they can [be] easy to guide through the hair of the user. (Office Action, page 4.)

Applicant respectfully submits that such a combination is not an obvious one. In support, Applicant submits herewith the Rule 132 declaration of Karen Giberson, president of The Accessories Council, an nationally recognized industry non-profit organization having offices in New York City, and someone having extensive experience in the fashion accessory business. Also submitted herewith, in support, is the Rule 132 declaration of Applicant, Francesca Kuglen. Both Rule 132 declarations declare as to the long felt need and unexpected results of Applicant’s invention, and to the commercial success and widespread copying of Applicant’s invention.

The JP ‘131 patent discloses a wire loop comb used by Japanese women singly as decorative picks in finished hairstyles. Kuglen 132 Declaration, ¶15. In the case of JP ‘131, the wire loop comb is provided with a spine construction for holding a combination of decorative elements, namely, a ribbon, an artificial flower, and a tassel. JP ‘131 does

not teach or suggest, nor, for reasons mentioned below, would it motivate a person of ordinary skill in the art to use such a comb in pairs in a stretch comb hair retainer as claimed by Applicant.

Wire loop combs such as disclosed in JP '131 are relatively light weight combs having flexible teeth that easily bend. Kuglen 132 Declaration, ¶¶6. While light weight wire loop combs might work as decorative picks worn singly in the hair, it was not obvious at the time of the invention that they could be used in pairs as anchoring elements of a stretch comb hair retainer where elastic strands secured between the spines of the comb exert forces on the combs. At the time of the invention, wire combs having flexible wire loop teeth would likely have been considered by the ordinary designer as relatively unstable in the hair, and unable to hold in place a stretch comb hair retainer as recited in claims 2, 21-22 and 29-31. Kuglen 132 Declaration, ¶¶¶6-8. At the time of the invention, it would have been counterintuitive to simply substitute light weight, flexible wire loop combs conventionally used as picks for the more sturdy combs associated with double comb hair accessories employing stretch elements. Kuglen 132 Declaration, ¶¶6-8; Giberson Declaration, ¶¶12.

It would also not have been obvious to a person of ordinary skill in the art at the time of the invention to use a wire loop comb as taught by JP '131 in pairs in a stretch comb hair retainer in order to achieve comfort or wearability. First, as indicated above, any consideration of using wire loop combs in pairs to retain and style the hair would, at

the time of the invention, have suggested greater instability in the hair, and thus less wearability and comfort, motivating against their use as anything other than decorative, non-holding picks in finished hairstyles. Also, wearability and comfort in terms of the comb's ability to resist tangling or snagging in the hair was not evident from the comb design, and a surprising result in view of the thin wire and loop construction of the combs, which, at the time of the invention, suggested snagging of the hair would occur. Kuglen 132 Declaration, ¶¶7 and 8; Giberson Declaration, ¶11. Other unpredicted advantages of Applicant's novel use of wire loop combs include the ability of women to wear a stretch comb hair retainer under a helmet without creating bulges that cause a condition known as "helmet head" and ability to insert the opposed combs in the hair without the comb teeth interlocking. Kuglen 132 Declaration, ¶9.

The non-obviousness of Applicant's stretch comb hair retainer as recited in claims 2, 21-22 and 29-31 is indicated by the commercial success of the hair retainer and the accolades Applicant's stretch comb hair retainer has received in the marketplace. It is also indicated by widespread copying of Applicant's stretch comb hair retainer, which is sold by Sennits, LLC under the brand names Hair Hugger and Hairzing. Kuglen 132 Declaration, ¶12. In her declaration, Ms. Giberson, a respected authority in the field of women's fashion accessories, characterizes Applicant's stretch comb hair retainer as one of the most innovative products she has ever encountered (a "game changer"), one that has become very successful as a woman's accessory item and one that has been

widely copied. Giberson declaration, ¶6. Ms. Giberson attributes the success of Applicant's stretch comb hair retainer product in part to the surprising advantages of the use of wire combs in this unique application. In addition to overcoming durability problems associated with plastic combs, they were found to hold the hair retainer in place without bending or sliding out of the hair. Giberson declaration, ¶ 8. They also exhibit another surprising advantage: a tendency to disappear in the hair so that the only readily visible portion of the combs is the ornamentation, such as might be provided by a bead pattern on the spine of the comb, transforming the look of the dual comb accessory from a relatively clunky look to a more fashionable look. Giberson declaration, ¶ 9.

As stated in Ms. Kuglen's declaration, Applicant's stretch comb hair retainer sold under the brand name Hair Hugger has been one of QVC's best selling hair accessory products, with nearly 400,000 hair retainers sold through QCV as of October 2008. In addition, Ms. Kuglen's company, Sennits, LLC, has sold over 150,000 of her stretch comb hair retainers since its inception in November 2006. Kuglen 132 Declaration, ¶¶13-14. Customer accolades include comments on the Hair Hugger's surprising ability to hold the customer's hair and to stay in place. Kuglen 132 Declaration, ¶¶15-16. As one customer exclaimed:

"Was I surprised when those little bitty wire combs were strong enough to hold all this! I still can't believe it."

Kuglen 132 Declaration, ¶16, Exhibit B.

Further, numerous copies have appeared in the market with the wire loop comb feature recited in claims 2, 21-22 and 29-31 (and previously presented claim 20 and new

claims 32-35). Kuglen 132 Declaration, ¶17. A common and significant attribute of all of these copies is the use of opposed wire loop combs.

For at least the foregoing reasons, Applicant respectfully submits that claims 2, 21-22 and 29-31 are patentable over Ruffio in view of JP '131, and respectfully requests that the Examiner's rejection of these claims under 35 U.S.C. 103 be withdrawn.

With respect to claim 5 which depends from claim 4 which depends from claim 1, Applicant respectfully requests reconsideration of this claim in light of Applicant's remarks with respect to claim 1. Ruffio does not disclose use of a stretchable elastic mesh formed by threadedly beadable elastic strands so as to form stretchable openings through which the wearer's hair can be pulled, much less the advantageous configuration of providing stretchable openings of at least two different sizes.

Applicant therefore respectfully requests the withdrawal of the Examiner's rejection of claim 5.

With respect to claims 12-14, these claims recite elements that depend from claim 1 and are patentable over Ruffio and JP '131 for at least the reasons set forth above with respect to claim 1. Applicant therefore respectfully requests the withdrawal of the Examiner's rejection of claims 12-14.

3. Claims 7-9, 15 and 23-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ruffio in view of U.S. Patent No. 1,564,079 to Lorbiecki ("Lorbiecki").

Lorbiecki discloses a common hair net with ornamenting elements (8) secured to the hair net by tying elements (9). Lorbiecki fails to disclose the use of elastic strands

and particularly fails to disclose or teach the use of elastic strands extending between opposed combs to produce stretchable openings. Nor does Lorbiecki suggest how beads could possibly be threaded onto the closely woven fabric material disclosed by Ruffio.

It is noted that claim 1, the base claim for claims 7-9, has been amended to clarify the elastic strands extending between the spines of the opposed combs are capable of being threadedly beaded to provide a decorative elastic mesh. Claims 15 and 23 have been amended to clarify that the elastic strands recited in these claims are beaded by threading.

For at least the foregoing reasons, Applicant respectfully submits that claims 7-9, 15 and 23-24 are patentable over Ruffio in view of Lorbiecki, and respectfully requests that the Examiner's rejection of these claims under 35 U.S.C. 103 be withdrawn.

4. Claims 10-11, 17-19 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ruffio in view of Lorbiecki, and further in view of U.S. Patent No. 5,154,196 to Moffat ("Moffat").

Claims 10-11, 17-19 and 25 all depend from claims which recite an elastic mesh formed by elastic strands extending between the spines of the combs so as to form stretchable openings which can individually be stretched open so that an amount of the wearer's hair can be pulled therethrough. As discussed above, an elastic mesh with such stretchable openings is not disclosed by Ruffio, nor is it disclosed or taught by Lorbiecki.

Moffat simply discloses the beading of hair barrettes using non-elastic beading

wire, and the use of additional beading wire and beads between the barrettes. The barrettes work independently of each other, and the beaded wires connected between the barrettes serve no function other than a decorative function. Moffat fails to disclose or teach the beading of an elastic mesh as recited in rejected claims 10-11, 17-19 and 25, wherein the mesh produces tension between opposed combs for retaining the combs in the hair while providing stretchable openings which can individually be stretched open to allow an amount of the wearer's hair to be pulled through the openings.

For at least the foregoing reasons, Applicant respectfully submits that claims 10-11, 17-19 and 25 are patentable over Ruffio in view of Lorbiecki and Moffat , and respectfully requests that the Examiner's rejection of these claims under 35 U.S.C. 103 be withdrawn.

5. Claim 20 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ruffio in view of Lorbiecki, and further in view of JP '131.

Claim 20, which depends from independent claim 15, recites that the opposed combs are wire combs comprised of a metal spine and a row of looped wires attached to and projecting from the metal spine. Ruffio and Lorbiecki fail to disclose or teach the use of wire loop combs, and, as discussed above, it would not have been obvious to a person of ordinary skill in the art to use such a comb in pairs in a stretch comb hair retainer as claimed by Applicant. See discussion of wire loop combs above. For at least these reasons and the reasons discussed in connection with wire loop combs, it is submitted that claim 20 is patentable over Ruffio in view of Lorbiecki and JP '131.

New Claims

New claims 32-35 each recite a stretch comb hair retainer having wire loop combs and a plurality of elastic strands. For at least the reasons discussed above regarding the use of wire loop combs in a stretch comb hair retainer, Applicant submits that new claims are patentably distinguishable over the prior art of record.

Supplemental Information Disclosure and Declaration of Applicant, Francesca Kuglen, Under 37 CFR 1.131

In a Supplemental Information Disclosure Statement accompanying this amendment and response, Applicant submits information supplied to Applicant's attorney by a third party, who is informed of the publication of this application, related to the product brochure titled Evita Peroni and dated "Summer 2003," which was submitted to the Examiner by Applicant with Applicant's Supplemental Information Disclosure Statement dated October 3, 2007. The currently disclosed information purports to show that the product shown in the Evita Peroni brochure, referred to as the "Elsamarie Comb," was described in a printed publication and/or sold in this country prior to the priority date of the present application (April 28, 2003), but less than one year before Applicant's priority date. Applicant does not admit to the accuracy of the statements or authenticity of the documents provided to Applicant's attorney regarding the Elsamarie Comb. Nonetheless, Applicant is filing herewith a declaration under 37 CFR 1.131 establishing a date of invention prior to the dates indicated in the materials related to the Elsamarie Comb submitted with Applicant's current Supplemental Information Disclosure

Statement, and declaring as to the possible origins of this product.

Also submitted with Applicant's current Supplemental Information Disclosure Statement are photographs of a stretch comb hair retainer designed by Applicant that was sold on QVC in May 2000. The stretch comb hair retainer is discussed by Applicant in Applicant's Rule 132 Declaration filed herewith at paragraphs 3-5.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests the withdrawal of the Examiner's claim rejections based upon 35 U.S.C. §102(b) and §103(a), and submits that the present application is in condition for allowance, a request for which is hereby respectfully made.

Respectfully Submitted,

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